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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
10/730,682	12/08/2003	Gerhard D. Klassen	555255012530	5722								
7590 David B. Cochran, Esq. JONES DAY North Point 901 Lakeside Ave Cleveland, OH 44114		12/12/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">PATEL, HARESH N</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>2154</td><td></td></tr></table>		EXAMINER		PATEL, HARESH N		ART UNIT	PAPER NUMBER	2154	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,682

Applicant(s)

KLASSEN ET AL.

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/14/2004.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 are subject to examination.

Drawings

2. The figures submitted on 12/8/03 are acknowledged.

Information Disclosure Statement

3. An initialed and dated copy of the applicant's IDS form 1449, paper dated 10/14/04, is attached to the instant Office action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2, 6-12, 14-17 and 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. The claims 1-2, 6-12, 14-17 claim a device having no hardware but having software components, and the claim 20, are software per se that is not tangibly embodied in a tangible computer storage medium such as memory or hardware entity and therefore lacks a practical application because it alone cannot produce its intended outcome.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hatscher et al. 2004/0122693 (Hereinafter Hatscher).

7. Referring to claim 1, Hatscher discloses a mobile instant messaging device for communicating instant messages with a plurality of instant message communities (e.g., page 2), comprising: a user interface for displaying a plurality community-specific icons, each community-specific icon providing an identification of one of the instant message communities (e.g., page 4); a plurality of configuration data files, each configuration data file being associated with one of the community-specific icons; and a common instant messaging application (e.g., page 4); wherein upon selecting one of the community-specific icons, the common instant messaging application is configured for use as a community-specific instant messaging application using the associated configuration data file (e.g., page 5).

8. Referring to claim 2, Hatscher discloses the claimed limitations as rejected above. Hatscher also discloses a database coupled to the common instant messaging application for

storing instant messaging data for each of the plurality of instant messaging communities (e.g., page 2).

9. Referring to claim 3, Hatscher discloses the claimed limitations as rejected above. Hatscher also discloses a wireless interface for communicating instant messages to a wireless data network (e.g., page 2).

10. Referring to claim 4, Hatscher discloses the claimed limitations as rejected above. Hatscher also discloses a display for displaying the user interface (e.g., page 4).

11. Referring to claim 5, Hatscher discloses the claimed limitations as rejected above. Hatscher also discloses a keyboard for entering instant messaging text into the mobile instant messaging device (e.g., page 2).

12. Referring to claim 6, Hatscher discloses the claimed limitations as rejected above. Hatscher also discloses wherein the user interface is a user interface ribbon (e.g., page 4).

13. Referring to claim 7, Hatscher discloses the claimed limitations as rejected above. Hatscher also discloses wherein the user interface ribbon is a one or two dimensional graphical set of icons, including the plurality of community-specific icons (e.g., page 4).

14. Referring to claim 8, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein the identification of one of the instant messaging communities is a textual identification (e.g., page 5).

15. Referring to claim 9, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein the identification of one of the instant messaging communities is a graphical identification (e.g., page 4).

16. Referring to claim 10, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein at least one of the plurality of community-specific icons is configured to display instant messaging information to a user of the mobile instant messaging device (e.g., page 5).

17. Referring to claim 11, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein the instant messaging information includes current presence information for the user with respect to the instant messaging community identified by the community specific icon (e.g., page 5).

18. Referring to claim 12, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein the instant messaging information includes a value indicating a number of received messages (e.g., page 6).

19. Referring to claim 13, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses a processor for configuring and executing the common instant messaging application (e.g., page 2).

20. Referring to claim 14, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein the configuration data file includes information which configures the functionality and appearance of the common instant messaging application so that it functions and appears like a community-specific instant messaging application. (e.g., page 7)

21. Referring to claim 15, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein the common instant messaging application monitors a trigger event for at least one of the instant messaging communities and upon detecting the trigger event, causes the user interface to display the community-specific icon for that instant messaging community (e.g., page 8).

22. Referring to claim 16, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein the trigger event is at least one of: (1) receiving an invitation to chat; (2) receiving a service book record that identifies a particular service accessible through one of the instant messaging communities; (3) entering of a secret code into the device; (4) activation of a download file; (5) clicking on a link in a browser; or (6) receiving an email with a control code for activating a particular service (e.g., page 7).

23. Referring to claim 17, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses wherein the community-specific icons, the configuration data files, and the common instant messaging application are stored in a Flash memory device within the mobile instant messaging device (e.g., page 6).

24. Referring to claim 18, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses a multi-community instant messaging system (e.g., page 2), comprising: a plurality of instant messaging communities; a network; and at least one mobile instant messaging device (e.g., page 2), the mobile instant messaging device comprising: a user interface for displaying a plurality community-specific icons, each community-specific icon providing an identification of one of the instant message communities; a plurality of configuration data files (e.g., page 4), each configuration data file being associated with one of the community-specific icons (e.g., page 4); and a common instant messaging application; wherein upon selecting one of the community-specific icons, the common instant messaging application is configured for use as a community-specific instant messaging application using the associated configuration data file (e.g., page 5), and may communicate instant messages over the network to the selected instant messaging community (e.g., page 5).

25. Referring to claim 19, Hatscher discloses the claimed limitations as rejected above.

Hatscher also discloses a method of instant messaging in a mobile communication device (e.g., page 2), comprising the steps of: displaying a plurality community-specific icons on a user interface of the device (e.g., page 2), each community-specific icon providing an identification of

one of a plurality of instant message communities (e.g., page 2); storing a plurality of configuration data files, each configuration data file being associated with one of the community-specific icons (e.g., page 4); selecting one of the community-specific icons; and in response to the selecting step (e.g., page 4), configuring a common instant messaging application for use as a community-specific instant messaging application using the associated configuration data file (e.g., page 5).

26. Referring to claim 20, Hatscher discloses the claimed limitations as rejected above. Hatscher also discloses a computer readable medium encoded with software instructions for performing the method of claim 19 on the mobile communication device (e.g., page 2).

27. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Papanikolaou et al. 2004/0049589 (Hereinafter Papanikolaou).

28. Referring to claim 1, Papanikolaou discloses a mobile instant messaging device for communicating instant messages with a plurality of instant message communities (e.g., page 6), comprising: a user interface for displaying a plurality community-specific icons, each community-specific icon providing an identification of one of the instant message communities (e.g., page 7); a plurality of configuration data files, each configuration data file being associated with one of the community-specific icons; and a common instant messaging application (e.g., page 7); wherein upon selecting one of the community-specific icons, the common instant messaging application is configured for use as a community-specific instant messaging application using the associated configuration data file (e.g., page 8).

29. Referring to claim 2, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses a database coupled to the common instant messaging application for storing instant messaging data for each of the plurality of instant messaging communities (e.g., page 6).

30. Referring to claim 3, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses a wireless interface for communicating instant messages to a wireless data network (e.g., page 6).

31. Referring to claim 4, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses a display for displaying the user interface (e.g., page 7).

32. Referring to claim 5, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses a keyboard for entering instant messaging text into the mobile instant messaging device (e.g., page 6).

33. Referring to claim 6, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses wherein the user interface is a user interface ribbon (e.g., page 7).

34. Referring to claim 7, Papanikolaou discloses the claimed limitations as rejected above.

Papanikolaou also discloses wherein the user interface ribbon is a one or two dimensional graphical set of icons, including the plurality of community-specific icons (e.g., page 7).

35. Referring to claim 8, Papanikolaou discloses the claimed limitations as rejected above.

Papanikolaou also discloses wherein the identification of one of the instant messaging communities is a textual identification (e.g., page 8).

36. Referring to claim 9, Papanikolaou discloses the claimed limitations as rejected above.

Papanikolaou also discloses wherein the identification of one of the instant messaging communities is a graphical identification (e.g., page 7).

37. Referring to claim 10, Papanikolaou discloses the claimed limitations as rejected above.

Papanikolaou also discloses wherein at least one of the plurality of community-specific icons is configured to display instant messaging information to a user of the mobile instant messaging device (e.g., page 8).

38. Referring to claim 11, Papanikolaou discloses the claimed limitations as rejected above.

Papanikolaou also discloses wherein the instant messaging information includes current presence information for the user with respect to the instant messaging community identified by the community specific icon (e.g., page 8).

39. Referring to claim 12, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses wherein the instant messaging information includes a value indicating a number of received messages (e.g., page 6).

40. Referring to claim 13, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses a processor for configuring and executing the common instant messaging application (e.g., page 6).

41. Referring to claim 14, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses wherein the configuration data file includes information which configures the functionality and appearance of the common instant messaging application so that it functions and appears like a community-specific instant messaging application. (e.g., page 7)

42. Referring to claim 15, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses wherein the common instant messaging application monitors a trigger event for at least one of the instant messaging communities and upon detecting the trigger event, causes the user interface to display the community-specific icon for that instant messaging community (e.g., page 8).

43. Referring to claim 16, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses wherein the trigger event is at least one of: (1) receiving an invitation to chat; (2) receiving a service book record that identifies a particular service

accessible through one of the instant messaging communities; (3) entering of a secret code into the device; (4) activation of a download file; (5) clicking on a link in a browser; or (6) receiving an email with a control code for activating a particular service (e.g., page 7).

44. Referring to claim 17, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses wherein the community-specific icons, the configuration data files, and the common instant messaging application are stored in a Flash memory device within the mobile instant messaging device (e.g., page 6).

45. Referring to claim 18, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses a multi-community instant messaging system (e.g., page 6), comprising: a plurality of instant messaging communities; a network; and at least one mobile instant messaging device (e.g., page 6), the mobile instant messaging device comprising: a user interface for displaying a plurality community-specific icons, each community-specific icon providing an identification of one of the instant message communities; a plurality of configuration data files (e.g., page 7), each configuration data file being associated with one of the community-specific icons (e.g., page 7); and a common instant messaging application; wherein upon selecting one of the community-specific icons, the common instant messaging application is configured for use as a community-specific instant messaging application using the associated configuration data file (e.g., page 8), and may communicate instant messages over the network to the selected instant messaging community (e.g., page 8).

46. Referring to claim 19, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses a method of instant messaging in a mobile communication device (e.g., page 6), comprising the steps of: displaying a plurality community-specific icons on a user interface of the device (e.g., page 6), each community-specific icon providing an identification of one of a plurality of instant message communities (e.g., page 6); storing a plurality of configuration data files, each configuration data file being associated with one of the community-specific icons (e.g., page 7); selecting one of the community-specific icons; and in response to the selecting step (e.g., page 7), configuring a common instant messaging application for use as a community-specific instant messaging application using the associated configuration data file (e.g., page 8).

47. Referring to claim 20, Papanikolaou discloses the claimed limitations as rejected above. Papanikolaou also discloses a computer readable medium encoded with software instructions for performing the method of claim 19 on the mobile communication device (e.g., page 6).

48. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchell et al. 2005/0050151 (Hereinafter Mitchell).

49. Referring to claim 1, Mitchell discloses a mobile instant messaging device for communicating instant messages with a plurality of instant message communities (e.g., page 4), comprising: a user interface for displaying a plurality community-specific icons, each community-specific icon providing an identification of one of the instant message communities (e.g., page 4); a plurality of configuration data files, each configuration data file being associated

with one of the community-specific icons; and a common instant messaging application (e.g., page 4); wherein upon selecting one of the community-specific icons, the common instant messaging application is configured for use as a community-specific instant messaging application using the associated configuration data file (e.g., page 6).

50. Referring to claim 2, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses a database coupled to the common instant messaging application for storing instant messaging data for each of the plurality of instant messaging communities (e.g., page 4).

51. Referring to claim 3, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses a wireless interface for communicating instant messages to a wireless data network (e.g., page 2).

52. Referring to claim 4, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses a display for displaying the user interface (e.g., page 4).

53. Referring to claim 5, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses a keyboard for entering instant messaging text into the mobile instant messaging device (e.g., page 4).

54. Referring to claim 6, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses wherein the user interface is a user interface ribbon (e.g., page 4).

55. Referring to claim 7, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses wherein the user interface ribbon is a one or two dimensional graphical set of icons, including the plurality of community-specific icons (e.g., page 4).

56. Referring to claim 8, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses wherein the identification of one of the instant messaging communities is a textual identification (e.g., page 6).

57. Referring to claim 9, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses wherein the identification of one of the instant messaging communities is a graphical identification (e.g., page 4).

58. Referring to claim 10, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses wherein at least one of the plurality of community-specific icons is configured to display instant messaging information to a user of the mobile instant messaging device (e.g., page 6).

59. Referring to claim 11, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses wherein the instant messaging information includes current presence

information for the user with respect to the instant messaging community identified by the community specific icon (e.g., page 6).

60. Referring to claim 12, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses wherein the instant messaging information includes a value indicating a number of received messages (e.g., page 6).

61. Referring to claim 13, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses a processor for configuring and executing the common instant messaging application (e.g., page 4).

62. Referring to claim 14, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses wherein the configuration data file includes information which configures the functionality and appearance of the common instant messaging application so that it functions and appears like a community-specific instant messaging application. (e.g., page 3)

63. Referring to claim 15, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses wherein the common instant messaging application monitors a trigger event for at least one of the instant messaging communities and upon detecting the trigger event, causes the user interface to display the community-specific icon for that instant messaging community (e.g., page 2).

64. Referring to claim 16, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses wherein the trigger event is at least one of: (1) receiving an invitation to chat; (2) receiving a service book record that identifies a particular service accessible through one of the instant messaging communities; (3) entering of a secret code into the device; (4) activation of a download file; (5) clicking on a link in a browser; or (6) receiving an email with a control code for activating a particular service (e.g., page 3).

65. Referring to claim 17, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses wherein the community-specific icons, the configuration data files, and the common instant messaging application are stored in a Flash memory device within the mobile instant messaging device (e.g., page 6).

66. Referring to claim 18, Mitchell discloses the claimed limitations as rejected above.

Mitchell also discloses a multi-community instant messaging system (e.g., page 4), comprising: a plurality of instant messaging communities; a network; and at least one mobile instant messaging device (e.g., page 4), the mobile instant messaging device comprising: a user interface for displaying a plurality community-specific icons, each community-specific icon providing an identification of one of the instant message communities; a plurality of configuration data files (e.g., page 4), each configuration data file being associated with one of the community-specific icons (e.g., page 4); and a common instant messaging application; wherein upon selecting one of the community-specific icons, the common instant messaging application is configured for use as a community-specific instant messaging application using the associated configuration data file

(e.g., page 6), and may communicate instant messages over the network to the selected instant messaging community (e.g., page 6).

67. Referring to claim 19, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses a method of instant messaging in a mobile communication device (e.g., page 4), comprising the steps of: displaying a plurality community-specific icons on a user interface of the device (e.g., page 4), each community-specific icon providing an identification of one of a plurality of instant message communities (e.g., page 4); storing a plurality of configuration data files, each configuration data file being associated with one of the community-specific icons (e.g., page 4); selecting one of the community-specific icons; and in response to the selecting step (e.g., page 4), configuring a common instant messaging application for use as a community-specific instant messaging application using the associated configuration data file (e.g., page 6).

68. Referring to claim 20, Mitchell discloses the claimed limitations as rejected above. Mitchell also discloses a computer readable medium encoded with software instructions for performing the method of claim 19 on the mobile communication device (e.g., page 4).

Conclusion

In order to expedite the prosecution of this case, multiple references are used for the rejections to demonstrate that several references disclose the claimed subject matter of the claims.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HARESH PATEL

PRIMARY EXAMINER

December 2, 2007